

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)	
)	Confirmation No: 6789
Mark Vaughn)	
)	Group Art Unit: 3609
Serial No.: 10/613,964)	
)	Examiner: Obeid, Fahd A.
Filed: July 3, 2003)	
)	
For: PRINT FULFILLMENT WITH)	Docket No.: 100202889-1
ECONOMICAL DELIVERY QUANTITIES)	

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief under 37 C.F.R. § 41.37 is submitted in support of the Notice of Appeal filed May 28, 2008, responding to the final Office Action mailed February 28, 2008.

It is not believed that extensions of time or fees are required to consider this Appeal Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required therefor are hereby authorized to be charged to Deposit Account No. 08-2025.

I. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. Related Appeals and Interferences

There are no known related appeals or interferences that will affect or be affected by a decision in this Appeal.

III. Status of Claims

Claims 1-25 stand finally rejected. The final rejections of claims 1-25 are appealed.

IV. Status of Amendments

No amendments have been made subsequent to the final Office Action mailed February 28, 2008. The claims in the attached Claims Appendix (see below) reflect the present state of Applicant's claims.

V. Summary of Claimed Subject Matter

The claimed inventions are summarized below with reference numerals and references to the written description ("specification") and drawings. The subject matter described in the following appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure.

Embodiments according to independent claim 1 describe a method for print fulfillment comprising maintaining a print quantity in a server (FIG. 1, 106), where the print quantity is associated with a recipient (FIG. 1, 119). Applicant's specification, page 9, lines 1-6. The method further comprises accumulating a collection of images received from an originator in the server (FIG. 1, 106), where the collection of images is associated with the recipient (FIG. 1, 119). Applicant's specification, page 6, lines 10-12. Such a method further comprises implementing a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity. Applicant's specification, page 6, lines 19-21.

Embodiments according to independent claim 10 describe a system for print fulfillment comprising a processor circuit having a processor (FIG. 2, 193) and a memory (FIG. 2, 196). The system further comprises an image printing system (FIG. 2, 126) stored in the memory (FIG. 2, 196) and executable by the processor (FIG. 2, 193), where the image printing system (FIG. 2, 126) further comprises a print quantity maintained in the memory (FIG. 2, 196). Applicant's specification, page 9, lines 1-6 and page 11, lines 16-19. The print quantity is associated with a recipient (FIG. 1, 119). Applicant's specification, page 6, lines 10-12. The image printing system (FIG. 2, 126) further comprises logic that accumulates a collection of images in the memory (FIG. 2,

196), where the images are received from an originator and the collection of images is associated with the recipient (FIG. 1, 119), and logic that implements a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity. Applicant's specification, page 6, lines 10-12 and 19-21 and page 24, lines 20-26.

Embodiments according to independent claim 19 describe a system for print fulfillment comprising means for maintaining (e.g., FIG. 2, 193, 196, 126) a print quantity associated with a recipient (FIG. 1, 119). Applicant's specification, page 9, lines 1-6. The system further comprises means for accumulating (e.g., FIG. 2, 193, 196, 126) a collection of images received from an originator, where the collection of images is associated with the recipient (FIG. 1, 119), Applicant's specification, page 6, lines 10-12, and means for implementing (e.g., FIG. 2, 193, 196, 126) a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity. Applicant's specification, page 6, lines 19-21.

Embodiments according to independent claim 22 describe a program embodied in a computer-readable medium for print fulfillment. Applicant's specification, page 28, lines 25-29. The program comprises code that maintains a print quantity in a memory (FIG. 2, 296), where the print quantity is associated with a recipient, Applicant's specification, page 9, lines 1-6 and page 28, lines 3-14, and code that accumulates a collection of images in the memory, where the images are received from an originator and the collection of images are associated with the recipient (FIG. 1, 119). Applicant's specification, page 6, lines 10-12 and page 28, lines 3-14. The program further

comprises code that implements a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity. Applicant's specification, page 6, lines 19-21 and page 28, lines 3-14.

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejections are to be reviewed on appeal:

Claims 1-25 have been rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent 7,013,288 issued to Reifel (hereafter "*Reifel*").

VII. Arguments

Claims 1-25 have been rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent 7,013,288 issued to Reifel (hereafter "*Reife*"). Anticipation under §102 "requires the disclosure in a single prior art reference of each element of the claim under construction." W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 313 (Fed. Cir. 1983). For the reasons that follow, Applicant requests that the rejection of claims 1-25 be overturned.

a. Applicant's Claim 1

To begin, claim 1 as originally filed states as follows:

1. A method for print fulfillment, comprising the steps of:
maintaining a print quantity in a server, the print quantity being associated with a recipient;
accumulating a collection of images received from an originator in the server, the collection of images being associated with the recipient; and

implementing a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity.

On page 3, the final Office action states as follows:

4. Regarding Claims 1, 10, 19, and 22: Reifel discloses a method for print fulfillment, comprising the steps of:

- Maintaining a print quantity in a server (col 2 lines 5-10 and col 6 lines 20-42).
- The print quantity being associated with a recipient (fig 8-9)
- Accumulating a collection of images received from an originator in the server, the collection of images being associated with the recipient (figs 8-9).
- Implementing a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity (figs 2-4, col 4 lines 20-30, col 13 lines 33-36, col 16 lines 19-37 and claim 11).

Applicant respectfully disagrees with the foregoing statements. Specifically, claim 1 includes the element of maintaining a print quantity in a server, the print quantity being associated with a recipient. With respect to this element, the Office action points to column 2, lines 5-10 and column 6, lines 20-42. At column 2, lines 5-10, *Reifel* states:

The images may be uploaded directly from a camera, or via a terminal networked to the server. The images are then decrypted and the consumer or others may then order copies of the images, ensuring that the camera provider receives income from print orders of images taken with the camera.

Also, at column 6, lines 20-42, *Reifel* states as follows:

If the provided camera 5 is a digital camera, the consumer 10 may upload the digital images to a server 26 or other system associated with an order taker 50, the camera provider 15 and/or related print house/image reproducer 25. Of course, the camera provider 15 and print house 25 may be the same entity. To simplify the following discussion, it will be assumed that the images are uploaded to the server 26 of the print house 25. The images may be uploaded by first transferring images from the camera 5 to a computer 45, and from the computer 45 to server 26 of the print house 25 via a network 40 such as the Internet or the like. In one

embodiment, images may be directly transferred from the camera 5 to the server 26 of the print house 25 if the camera 5 is network-able via a built-in wired or wireless modem or other interface, such as a serial port, a USB port, or a wireless interface, such as a Bluetooth or a wireless DSL interface, via a coupled cellular phone or via a removable memory module used to store images. The consumer may then view the images on a terminal, such a computer or PDA, connected to the print house site and may order prints 35 or other reproductions of the desired images. Upon uploading the digital images to the server 26, the images are retained in the image database 28.

In neither of the excerpts set forth above, nor in any other portion, does *Reifel* discuss maintaining a print quantity in a server. Rather, *Reifel* describes a contract that requires a minimum number of prints that have to be printed by a consumer. This is not a print quantity that relates to a quantity of images to be printed when such quantity is breached. In contrast, this is a quantity that a consumer is obligated to pay in exchange for leasing a camera. See col. 8-9, lines 65-10 ("To further ensure that the consumer meets his or her commitment as defined in the contract 12 to order a certain number of reproductions, the consumer may be required to provide a credit card and/or to provide authorization to charge the credit card or other financial instrument associated with the consumer a selected amount should the consumer fail to fulfill the commitment, before providing the camera 5. Alternatively, the consumer may optionally prepay the cost of the committed to reproductions. Thus, for example, if the consumer has agreed to purchase 500 prints within a year at a cost of 30 a print, the consumer can prepay \$150, and so does not have to be concerned about meeting any order commitments 12.")

In addition, claim 1 further states the element of "implementing a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity." As set forth above, the images

are printed when the total number of images included in the collection stored in the server reaches the print quantity maintained in the server for a recipient.

Reifel describes selling digital cameras at reduced cost along with a contract that requires the user to purchase prints from the manufacturer so that the manufacturer can recover the costs of the reduced price from the camera. *Reifel* does not show or suggest the concept of only printing images when a print quantity of images associated with a recipient is stored in the server and breached, where images are uploaded to the server over time. While *Reifel* does specify that a minimum order of prints need to be purchased from the manufacturer in order to make up for the loss of revenue by selling cameras at reduced prices, these images are printed at any time. There is no discussion as to whether the images should be printed in predefined print quantities with respect to a recipient.

The various embodiments of the present invention provide at least one advantage in that collections of images from a given user are maintained in a server in association with a recipient. Such images are uploaded to the server over time. Even though the images are uploaded over time, they are not printed and mailed to the recipient until a print quantity is reached. This ensures that a minimum quantity of prints is shipped together to the recipient so as to minimize shipping costs. In this respect, if images are printed and shipped to a recipient immediately after they are uploaded, then varying quantities of prints may be shipped at any given time.

This can result in varying levels of shipping costs associated with such printing and shipping of the images. *Reifel* does not even contemplate addressing this problem. Rather, *Reifel* merely assumes that once prints are ordered, they are shipped without

regard for the shipping costs or for setting optimum shipping quantities with respect to a recipient of the ordered prints. If a consumer frequently orders small number of prints over time, it is possible they will pay more in terms of shipping costs over time than if they had ordered greater quantities of prints farther apart.

For at least the reasons discussed above, Applicant respectfully asserts that *Reifel* fails to show or suggest each of the elements of claim 1, such as “maintaining a print quantity in a server, the print quantity being associated with a recipient” and “implementing a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity,” as recited in claim 1.

Therefore, claim 1 is not anticipated by *Reifel*, and the rejection should be overturned.

b. Applicant's Claims 2-9

Dependent claims 2-9 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-9 contain all the features of allowable independent claim 1. For at least this reason, the rejections of claims 2-9 should be overturned.

c. Applicant's Claim 10

Applicant asserts that *Reifel* fails to show or suggest each of the features of claim 10 to the extent they incorporate subject matter similar in scope with that of claim 1. Therefore, Applicant requests that the rejection of claim 10 be withdrawn.

Claim 10 states as follows:

10. A system for print fulfillment, comprising:
 - a processor circuit having a processor and a memory;
 - an image printing system stored in the memory and executable by the processor, the image printing system further comprising:
 - a print quantity maintained in the memory, the print quantity being associated with a recipient;
 - logic that accumulates a collection of images in the memory, the images being received from an originator and the collection of images being associated with the recipient; and
 - logic that implements a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity.

On page 3, the final Office action states as follows:

4. Regarding Claims 1, 10, 19, and 22: Reifel discloses a method for print fulfillment, comprising the steps of:
 - Maintaining a print quantity in a server (col 2 lines 5-10 and col 6 lines 20-42).
 - The print quantity being associated with a recipient (fig 8-9)
 - Accumulating a collection of images received from an originator in the server, the collection of images being associated with the recipient (figs 8-9).
 - Implementing a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity (figs 2-4, col 4 lines 20-30, col 13 lines 33-36, col 16 lines 19-37 and claim 11).

Applicant respectfully disagrees with the foregoing statements. Specifically, claim 10 includes a print quantity maintained in the memory, where the print quantity is associated with a recipient. With respect to this feature, the Office action points to column 2, lines 5-10 and column 6, lines 20-42. At column 2, lines 5-10, *Reifel* states:

The images may be uploaded directly from a camera, or via a terminal networked to the server. The images are then decrypted and the consumer or others may then order copies of the images, ensuring that

the camera provider receives income from print orders of images taken with the camera.

Also, at column 6, lines 20-42, *Reifel* states as follows:

If the provided camera 5 is a digital camera, the consumer 10 may upload the digital images to a server 26 or other system associated with an order taker 50, the camera provider 15 and/or related print house/image reproducer 25. Of course, the camera provider 15 and print house 25 may be the same entity. To simplify the following discussion, it will be assumed that the images are uploaded to the server 26 of the print house 25. The images may be uploaded by first transferring images from the camera 5 to a computer 45, and from the computer 45 to server 26 of the print house 25 via a network 40 such as the Internet or the like. In one embodiment, images may be directly transferred from the camera 5 to the server 26 of the print house 25 if the camera 5 is network-able via a built-in wired or wireless modem or other interface, such as a serial port, a USB port, or a wireless interface, such as a Bluetooth or a wireless DSL interface, via a coupled cellular phone or via a removable memory module used to store images. The consumer may then view the images on a terminal, such a computer or PDA, connected to the print house site and may order prints 35 or other reproductions of the desired images. Upon uploading the digital images to the server 26, the images are retained in the image database 28.

In neither of the excerpts set forth above, nor in any other portion, does *Reifel* discuss maintaining a print quantity in memory that is associated with a recipient. Rather, *Reifel* describes a contract that requires a minimum number of prints that have to be printed by a consumer. This is not a print quantity that relates to a quantity of images to be printed when such quantity is breached. In contrast, this is a quantity that a consumer is obligated to pay in exchange for leasing a camera. See col. 8-9, lines 65-10 ("To further ensure that the consumer meets his or her commitment as defined in the contract 12 to order a certain number of reproductions, the consumer may be required to provide a credit card and/or to provide authorization to charge the credit card or other financial instrument associated with the consumer a selected amount should the consumer fail to fulfill the commitment, before providing the camera 5. Alternatively,

the consumer may optionally prepay the cost of the committed to reproductions. Thus, for example, if the consumer has agreed to purchase 500 prints within a year at a cost of 30 a print, the consumer can prepay \$150, and so does not have to be concerned about meeting any order commitments 12.”)

In addition, claim 10 further states the element of “logic that implements a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity.” As set forth above, the images are printed when the total number of images included in the collection stored in memory reaches the print quantity maintained in memory for a recipient.

Reifel describes selling digital cameras at reduced cost along with a contract that requires the user to purchase prints from the manufacturer so that the manufacturer can recover the costs of the reduced price from the camera. *Reifel* does not show or suggest the concept of only printing images when a print quantity of images associated with a recipient is stored in the server and breached, where images are uploaded to the server over time. While *Reifel* does specify that a minimum order of prints need to be purchased from the manufacturer in order to make up for the loss of revenue by selling cameras at reduced prices, these images are printed at any time. There is no discussion as to whether the images should be printed in predefined print quantities with respect to a recipient.

The various embodiments of the present invention provide at least one advantage in that collections of images from a given user are maintained in memory in association with a recipient. Even though the images are uploaded over time, they are

not printed and mailed to the recipient until a print quantity is reached. This ensures that a minimum quantity of prints is shipped together to the recipient so as to minimize shipping costs. In this respect, if images are printed and shipped to a recipient immediately after they are uploaded, then varying quantities of prints may be shipped at any given time.

This can result in varying levels of shipping costs associated with such printing and shipping of the images. *Reifel* does not even contemplate addressing this problem. Rather, *Reifel* merely assumes that once prints are ordered, they are shipped without regard for the shipping costs or for setting optimum shipping quantities with respect to a recipient of the ordered prints. If a consumer frequently orders small number of prints over time, it is possible they will pay more in terms of shipping costs over time than if they had ordered greater quantities of prints farther apart.

For at least the reasons discussed above, Applicant respectfully asserts that *Reifel* fails to show or suggest each of the elements of claim 10, such as “a print quantity maintained in the memory, the print quantity being associated with a recipient; logic that accumulates a collection of images in the memory, the images being received from an originator and the collection of images being associated with the recipient; and logic that implements a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity,” as recited in claim 10.

Therefore, claim 10 is not anticipated by *Reifel*, and the rejection should be overturned.

d. Applicant's Claims 11-18

Dependent claims 11-18 (which depend from independent claim 10) are allowable as a matter of law for at least the reason that dependent claims 11-18 contain all the features of allowable independent claim 10. For at least this reason, the rejections of claims 11-18 should be overturned.

e. **Applicant's Claim 19**

Claim 19 states as follows:

19. A system for print fulfillment, comprising:
means for maintaining a print quantity associated with a recipient;
means for accumulating a collection of images received from an originator, the collection of images being associated with the recipient;
and
means for implementing a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity.

On page 3, the final Office action states as follows:

4. Regarding Claims 1, 10, 19, and 22: Reifel discloses a method for print fulfillment, comprising the steps of:
- Maintaining a print quantity in a server (col 2 lines 5-10 and col 6 lines 20-42).
 - The print quantity being associated with a recipient (fig 8-9)
 - Accumulating a collection of images received from an originator in the server, the collection of images being associated with the recipient (figs 8-9).
 - Implementing a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity (figs 2-4, col 4 lines 20-30, col 13 lines 33-36, col 16 lines 19-37 and claim 11).

Applicant respectfully disagrees with the foregoing statements. Specifically, claim 19 includes the element of means for maintaining a print quantity associated with

a recipient. With respect to this element, the Office action points to column 2, lines 5-10 and column 6, lines 20-42. At column 2, lines 5-10, *Reifel* states:

The images may be uploaded directly from a camera, or via a terminal networked to the server. The images are then decrypted and the consumer or others may then order copies of the images, ensuring that the camera provider receives income from print orders of images taken with the camera.

Also, at column 6, lines 20-42, *Reifel* states as follows:

If the provided camera 5 is a digital camera, the consumer 10 may upload the digital images to a server 26 or other system associated with an order taker 50, the camera provider 15 and/or related print house/image reproducer 25. Of course, the camera provider 15 and print house 25 may be the same entity. To simplify the following discussion, it will be assumed that the images are uploaded to the server 26 of the print house 25. The images may be uploaded by first transferring images from the camera 5 to a computer 45, and from the computer 45 to server 26 of the print house 25 via a network 40 such as the Internet or the like. In one embodiment, images may be directly transferred from the camera 5 to the server 26 of the print house 25 if the camera 5 is network-able via a built-in wired or wireless modem or other interface, such as a serial port, a USB port, or a wireless interface, such as a Bluetooth or a wireless DSL interface, via a coupled cellular phone or via a removable memory module used to store images. The consumer may then view the images on a terminal, such a computer or PDA, connected to the print house site and may order prints 35 or other reproductions of the desired images. Upon uploading the digital images to the server 26, the images are retained in the image database 28.

In neither of the excerpts set forth above, nor in any other portion, does *Reifel* discuss maintaining a print quantity associated with a recipient. Rather, *Reifel* describes a contract that requires a minimum number of prints that have to be printed by a consumer. This is not a print quantity that relates to a quantity of images to be printed when such quantity is breached. In contrast, this is a quantity that a consumer is obligated to pay in exchange for leasing a camera. See col. 8-9, lines 65-10 ("To further ensure that the consumer meets his or her commitment as defined in the

contract 12 to order a certain number of reproductions, the consumer may be required to provide a credit card and/or to provide authorization to charge the credit card or other financial instrument associated with the consumer a selected amount should the consumer fail to fulfill the commitment, before providing the camera 5. Alternatively, the consumer may optionally prepay the cost of the committed to reproductions. Thus, for example, if the consumer has agreed to purchase 500 prints within a year at a cost of 30 a print, the consumer can prepay \$150, and so does not have to be concerned about meeting any order commitments 12.”)

In addition, claim 19 further states the element of “means for implementing a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity.” As set forth above, the images are printed when the total number of images included in the collection reaches the print quantity maintained for a recipient.

Reifel describes selling digital cameras at reduced cost along with a contract that requires the user to purchase prints from the manufacturer so that the manufacturer can recover the costs of the reduced price from the camera. *Reifel* does not show or suggest the concept of only printing images when a print quantity of images associated with a recipient is beached. While *Reifel* does specify that a minimum order of prints need to be purchased from the manufacturer in order to make up for the loss of revenue by selling cameras at reduced prices, these images are printed at any time. There is no discussion as to whether the images should be printed in predefined print quantities with respect to a recipient.

The various embodiments of the present invention provide at least one advantage in that collections of images from a given user are maintained in association with a recipient. Even though the images are uploaded over time, they are not printed and mailed to the recipient until a print quantity is reached. This ensures that a minimum quantity of prints is shipped together to the recipient so as to minimize shipping costs. In this respect, if images are printed and shipped to a recipient immediately after they are uploaded, then varying quantities of prints may be shipped at any given time.

This can result in varying levels of shipping costs associated with such printing and shipping of the images. *Reifel* does not even contemplate addressing this problem. Rather, *Reifel* merely assumes that once prints are ordered, they are shipped without regard for the shipping costs or for setting optimum shipping quantities with respect to a recipient of the ordered prints. If a consumer frequently orders small number of prints over time, it is possible they will pay more in terms of shipping costs over time than if they had ordered greater quantities of prints farther apart.

For at least the reasons discussed above, Applicant respectfully asserts that *Reifel* fails to show or suggest each of the elements of claim 19, such as “means for maintaining a print quantity associated with a recipient” and “means for implementing a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity,” as recited in claim 19.

Therefore, claim 19 is not anticipated by *Reifel*, and the rejection should be overturned.

f. Applicant's Claims 20-21

Dependent claims 20-21 (which depend from independent claim 19) are allowable as a matter of law for at least the reason that dependent claims 20-21 contain all the features of allowable independent claim 19. For at least this reason, the rejections of claims 20-21 should be overturned.

g. Applicant's Claim 22

Claim 22 states as follows:

22. A program embodied in a computer-readable medium for print fulfillment, comprising:
code that maintains a print quantity in a memory, the print quantity being associated with a recipient;
code that accumulates a collection of images in the memory, the images being received from an originator and the collection of images being associated with the recipient; and
code that implements a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity.

On page 3, the final Office action states as follows:

4. Regarding Claims 1, 10, 19, and 22: Reifel discloses a method for print fulfillment, comprising the steps of:

- Maintaining a print quantity in a server (col 2 lines 5-10 and col 6 lines 20-42).
- The print quantity being associated with a recipient (fig 8-9)
- Accumulating a collection of images received from an originator in the server, the collection of images being associated with the recipient (figs 8-9).
- Implementing a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity (figs 2-4, col 4 lines 20-30, col 13 lines 33-36, col 16 lines 19-37 and claim 11).

Applicant respectfully disagrees with the foregoing statements. Specifically, claim 22 includes the element of code that maintains a print quantity in a memory, the

print quantity being associated with a recipient. With respect to this element, the Office action points to column 2, lines 5-10 and column 6, lines 20-42. At column 2, lines 5-10,

Reifel states:

The images may be uploaded directly from a camera, or via a terminal networked to the server. The images are then decrypted and the consumer or others may then order copies of the images, ensuring that the camera provider receives income from print orders of images taken with the camera.

Also, at column 6, lines 20-42, *Reifel* states as follows:

If the provided camera 5 is a digital camera, the consumer 10 may upload the digital images to a server 26 or other system associated with an order taker 50, the camera provider 15 and/or related print house/image reproducer 25. Of course, the camera provider 15 and print house 25 may be the same entity. To simplify the following discussion, it will be assumed that the images are uploaded to the server 26 of the print house 25. The images may be uploaded by first transferring images from the camera 5 to a computer 45, and from the computer 45 to server 26 of the print house 25 via a network 40 such as the Internet or the like. In one embodiment, images may be directly transferred from the camera 5 to the server 26 of the print house 25 if the camera 5 is network-able via a built-in wired or wireless modem or other interface, such as a serial port, a USB port, or a wireless interface, such as a Bluetooth or a wireless DSL interface, via a coupled cellular phone or via a removable memory module used to store images. The consumer may then view the images on a terminal, such a computer or PDA, connected to the print house site and may order prints 35 or other reproductions of the desired images. Upon uploading the digital images to the server 26, the images are retained in the image database 28.

In neither of the excerpts set forth above, nor in any other portion, does *Reifel* discuss maintaining a print quantity associated with a recipient. Rather, *Reifel* describes a contract that requires a minimum number of prints that have to be printed by a consumer. This is not a print quantity that relates to a quantity of images to be printed when such quantity is breached. In contrast, this is a quantity that a consumer is obligated to pay in exchange for leasing a camera. See col. 8-9, lines 65-10 ("To

further ensure that the consumer meets his or her commitment as defined in the contract 12 to order a certain number of reproductions, the consumer may be required to provide a credit card and/or to provide authorization to charge the credit card or other financial instrument associated with the consumer a selected amount should the consumer fail to fulfill the commitment, before providing the camera 5. Alternatively, the consumer may optionally prepay the cost of the committed to reproductions. Thus, for example, if the consumer has agreed to purchase 500 prints within a year at a cost of 30 a print, the consumer can prepay \$150, and so does not have to be concerned about meeting any order commitments 12.”)

In addition, claim 22 further states the element of “code that implements a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity.” As set forth above, the images are printed when the total number of images included in the collection reaches the print quantity maintained for a recipient.

Reifel describes selling digital cameras at reduced cost along with a contract that requires the user to purchase prints from the manufacturer so that the manufacturer can recover the costs of the reduced price from the camera. *Reifel* does not show or suggest the concept of only printing images when a print quantity of images associated with a recipient is beached. While *Reifel* does specify that a minimum order of prints need to be purchased from the manufacturer in order to make up for the loss of revenue by selling cameras at reduced prices, these images are printed at any time. There is no discussion as to whether the images should be printed in predefined print quantities with respect to a recipient.

The various embodiments of the present invention provide at least one advantage in that collections of images from a given user are maintained in association with a recipient. Even though the images are uploaded over time, they are not printed and mailed to the recipient until a print quantity is reached. This ensures that a minimum quantity of prints is shipped together to the recipient so as to minimize shipping costs. In this respect, if images are printed and shipped to a recipient immediately after they are uploaded, then varying quantities of prints may be shipped at any given time.

This can result in varying levels of shipping costs associated with such printing and shipping of the images. *Reifel* does not even contemplate addressing this problem. Rather, *Reifel* merely assumes that once prints are ordered, they are shipped without regard for the shipping costs or for setting optimum shipping quantities with respect to a recipient of the ordered prints. If a consumer frequently orders small number of prints over time, it is possible they will pay more in terms of shipping costs over time than if they had ordered greater quantities of prints farther apart.

For at least the reasons discussed above, Applicant respectfully asserts that *Reifel* fails to show or suggest each of the elements of claim 22, such as “code that maintains a print quantity in a memory, the print quantity being associated with a recipient” and “code that implements a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity,” as recited in claim 22.

Therefore, claim 22 is not anticipated by *Reifel*, and the rejection should be overturned.

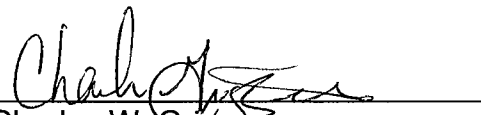
h. Applicant's Claims 23-25

Dependent claims 23-25 (which depend from independent claim 22) are allowable as a matter of law for at least the reason that dependent claims 23-25 contain all the features of allowable independent claim 22. For at least this reason, the rejections of claims 23-25 should be overturned.

VIII. Conclusion

In summary, it is Applicant's position that Applicant's claims are patentable over the applied cited art references and that the rejection of these claims should be overturned. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

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Claims Appendix under 37 C.F.R. § 41.37(c)(1)(viii)

The following are the claims that are involved in this Appeal.

1. A method for print fulfillment, comprising the steps of:
maintaining a print quantity in a server, the print quantity being associated with a recipient;
accumulating a collection of images received from an originator in the server, the collection of images being associated with the recipient; and
implementing a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity.

2. The method of claim 1, wherein the step of implementing the printing of the image included in the collection of images when the total number of the images included in the collection of images breaches the print quantity further comprises the steps of:
printing each of the images in the collection of images; and
shipping the images to the recipient.

3. The method of claim 1, wherein the step of implementing the printing of the images included in the collection of images when the total number of the images included in the collection of images breaches the print quantity further comprises the steps of:

transmitting each of the images in the collection of images to a print vendor for printing; and

transmitting a ship address associated with the recipient to the print vendor to facilitate shipping of printed ones of the image to the recipient.

4. The method of claim 3, further comprising the step of tracking a total number of the images transmitted to the print vendor for printing.

5. The method of claim 1, further comprising the step of implementing the printing of the images included in the collection of images upon receipt of an order for immediate printing of the collection of images from the originator.

6. The method of claim 1, wherein the step of accumulating the collection of images received from the originator in the server further comprises the steps of:

receiving a number of images from the originator;

adding each of the number of images to the collection of images; and

determining if the total number of the images included in the collection of images breaches the print quantity after adding each of the number of images to the collection of images.

7. The method of claim 1, further comprising the step of acknowledging a receipt of a number of images to the originator.

8. The method of claim 1, further comprising the step of sending a print notification to the originator when the total number of the images included in the collection of images breaches the print quantity.

9. The method of claim 1, further comprising the step of obtaining a payment for the implementation of the printing of the images included in the collection of images when the total number of the images included in the collection of images breaches the print quantity.

10. A system for print fulfillment, comprising:

- a processor circuit having a processor and a memory;
- an image printing system stored in the memory and executable by the processor, the image printing system further comprising:
 - a print quantity maintained in the memory, the print quantity being associated with a recipient;
 - logic that accumulates a collection of images in the memory, the images being received from an originator and the collection of images being associated with the recipient; and
 - logic that implements a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity.

11. The system of claim 10, wherein the logic that implements the printing of the images included in the collection of images when the total number of the images included in the collection of images breaches the print quantity further comprises logic that automatically interfaces with a printer to print each of the images in the collection of images for shipment to the recipient.

12. The system of claim 10, wherein the logic that implements the printing of the images included in the collection of images when the total number of the images included in the collection of images breaches the print quantity further comprises:

logic that automatically transmits each of the images in the collection of images to a print vendor for printing; and

logic that transmits a shipping address associated with the recipient to the print vendor to facilitate shipping of printed ones of the image to the recipient.

13. The system of claim 12, further comprising logic that tracks a total number of the images transmitted to the print vendor for printing.

14. The system of claim 10, further comprising logic that implements the printing of the images included in the collection of images upon receipt of an order for immediate printing of the collection of images from the originator.

15. The system of claim 10, wherein the logic that accumulates the collection of images in the memory further comprises:

logic that adds a number of the images received from the originator to the collection of images; and

logic that determines if the total number of the images included in the collection of images breaches the print quantity after adding each of the number of images to the collection of images.

16. The system of claim 10, further comprising logic that automatically transmits an acknowledgement of a receipt of a number of images to the originator.

17. The system of claim 10, further comprising logic that automatically transmits a print notification to the originator when the total number of the images included in the collection of images breaches the print quantity.

18. The system of claim 10, further comprising logic that transmits a payment interface to the originator to obtain a payment for the implementation of the printing of the images included in the collection of images when the total number of the images included in the collection of images breaches the print quantity.

19. A system for print fulfillment, comprising:
means for maintaining a print quantity associated with a recipient;
means for accumulating a collection of images received from an originator, the collection of images being associated with the recipient; and
means for implementing a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity.

20. The system of claim 19, wherein the means for implementing the printing of the images included in the collection of images when the total number of the images included in the collection of images breaches the print quantity further comprises means for automatically interfacing with a printer to print each of the images in the collection of images for shipment to the recipient.

21. The system of claim 19, wherein the means for implementing the printing of the images included in the collection of images when the total number of the images included in the collection of images breaches the print quantity further comprises:

means for automatically transmitting each of the images in the collection of images to a print vendor for printing; and

means for transmitting a shipping address associated with the recipient to the print vendor to facilitate shipping of printed ones of the image to the recipient.

22. A program embodied in a computer-readable medium for print fulfillment, comprising:

code that maintains a print quantity in a memory, the print quantity being associated with a recipient;

code that accumulates a collection of images in the memory, the images being received from an originator and the collection of images being associated with the recipient; and

code that implements a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity.

23. The program embodied in the computer-readable medium of claim 22, wherein the code that implements the printing of the images included in the collection of images when the total number of the images included in the collection of images breaches the print quantity further comprises code that automatically interfaces with a printer to print each of the images in the collection of images for shipment to the recipient.

24. The program embodied in the computer-readable medium of claim 22, wherein the code that implements the printing of the images included in the collection of images when the total number of the images included in the collection of images breaches the print quantity further comprises:

code that automatically transmits each of the images in the collection of images to a print vendor for printing; and

code that transmits a shipping address associated with the recipient to the print vendor to facilitate shipping of printed ones of the image to the recipient.

25. The program embodied in the computer-readable medium of claim 22, wherein the code that accumulates the collection of images in the memory further comprises:

code that adds a number of the images received from the originator to the collection of images; and

code that determines if the total number of the images included in the collection of images breaches the print quantity after adding each of the number of the images to the collection of images.

Evidence Appendix under 37 C.F.R. § 41.37(c)(1)(ix)

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

Related Proceedings Appendix under 37 C.F.R. § 41.37(c)(1)(x)

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.